

REMARKS

Turning first to the rejection of claims 10-11 as being non-enabled, Applicant respectfully traverses. According to the Manual of Patent Examining Procedure,

[a]ny analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

MPEP 2164.01.

Here, the specification specifically explains that the pump with a “smooth output” can be a “gear pump” with a “non-pulsating . . . output” (see p.6, lines 15-17), and specifically contrasts this with a pump having a non-smooth output for which a damper may be used. A skilled artisan would readily understand the meaning of the phrase at issue, and would be able to select a suitable pump with such non-pulsating output (especially given the example of a gear pump). The Examiner has not established otherwise, or explained why it would constitute “undue experimentation” to practice the invention (indeed, the Examiner contends that the cited Sund reference discloses a pump with a “smooth output,” which thus suggests that a pump having such characteristic is understood by those of ordinary skill in the art). Accordingly, a *prima facie* case of non-enablement is lacking.

As for the anticipation rejections, Applicant again respectfully traverses. As the law provides, an anticipation rejection requires “strict identity” between the prior art invention and the one set forth in the claim. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (stating “[t]he identical invention must be shown in as complete detail as is contained in the patent claim”). The “mere possibility” that the claimed structure exists in the reference is inadequate to meet the “strict identity” requirement for a proper anticipation rejection.

*See Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 1269, 20 USPQ2d 1746 (Fed. Cir. 1991) (holding anticipation “may not be established by probabilities or possibilities”).

The Examiner contends that Sund discloses a “digital flow meter 512.” However, the word “digital” does not appear anywhere in the Sund reference in connection with the flow meter 512. The “mere possibility” that the flow meter is “digital” cannot qualify as meeting the strict identity requirement for an anticipation rejection. Accordingly, withdrawal of the rejection is in order.

As for obviousness, the Examiner does not contend that any of the secondary references cited disclose the claimed digital mass flow meter. Accordingly, these references alone or taken in combination cannot supply the teaching missing from Sund in order to establish a *prima facie* case of obviousness for claim 1.

Regarding claim 4, the Examiner finds it recites an invention that is obvious, given that Sund in one embodiment discloses a flow control valve 110 “immediately upstream” of a flow control meter. Again, however, Sund does not disclose a digital flow meter, as claim 4 requires, and the Examiner does not in any way explain why a skilled artisan would find it obvious to use such a device in the Sund arrangement (without the benefit of Applicant’s teaching using hindsight, of course).

As for claim 5, the Examiner relies on the teachings of the Sund reference in combination with U.S. Patent Application Publication 2003/0056695 to Macklin et al. to contend the recited invention is obvious under 35 U.S.C. Section 103(a). In such instance, “the examiner bears the initial burden of presenting a *prima facie* case of obviousness.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). In doing so under current Office procedures, evidentiary support for a reason for combining two references is a requirement of a *prima facie* case of obviousness. *See* Memorandum of Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007 (“in formulating a rejection under 35 U.S.C. 103(a) based upon a combination of prior art elements, **it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements**”).

in the manner claimed . . .”) (emphasis added). Indeed, current Supreme Court precedent recognizes that the ability to “merely demonstrat[e] that each of its elements was, independently, known in the prior art” is insufficient to establish obviousness. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398; 127 S. Ct. 1727, 167 L. Ed. 2d 705 (U.S. 2007) (holding that obviousness cannot be proven “merely by demonstrating that each of its elements was, independently, known in the prior art . . .”) (emphasis added). Rather, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements.” *Id.* at 1741. A proper “reason” must also have a rational underpinning, which must be articulated in the record. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

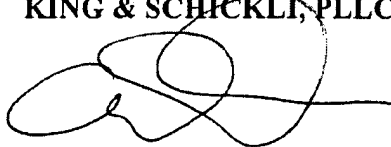
Here, the statement made in support of the rejection is that “[i]t would have been obvious to one of ordinary skill in the art to adapt Macklin to Sund because Macklin provides a way to more reliably create a smooth output of fluid from the system” (Office Action p. 4, ¶ 12). Respectfully, simply reciting a feature from one of the references does not qualify as a proper reason “that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements.” *KSR, supra*. Rather, all the Examiner has done is show that the claimed elements were, independently, known in the art, which according to *KSR* is insufficient to establish obviousness. Accordingly, a *prima facie* case of obviousness is lacking and withdrawal of the rejections is thus in order.

Finally, Applicant presents new claim 12 for consideration. This claim reads on an apparatus for dispensing measured batches of liquid comprising a pump for supplying liquid under pressure to a batch dispensing valve by way of a digital mass flow meter and a controller for controlling the valve in accordance with information received from the meter. Again, none of the cited prior art discloses the claimed digital mass flow meter in the combination, so favorable consideration of this claim is in order.

In light of the foregoing, it is now believed that all pending claims are allowable. If any issues remain, the Examiner is encouraged to contact Applicant's counsel at the telephone number listed below in order to reduce costs and expedite the prosecution of this patent application. To the extent any fees are due for processing this response, the undersigned authorizes their deduction from Deposit Account 11-0978.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Andrew D. Dorisio', written over the firm name.

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